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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/489,250 01/21/00 PHILLIPS

R 13676.152

022913 MM91/0815  
WORKMAN NYDEGGER & SEELEY  
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EXAMINER

SCHUBERG, D  
ART UNIT PAPER NUMBER

2872  
DATE MAILED:

08/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/489,250

Applicant(s)

PHILLIPS ET, AL.

Examiner

Darren Schuberg

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.  
4a) Of the above claim(s) 1-18, 15-65, 1-28, 9-65, 69, 71-75 and 78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 14, 66-68, 76 and 77 is/are rejected.
- 7) ☒ Claim(s) 6, 8 and 70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6. 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 1-8, 14, 66-68, 70 and 76-78 in Paper No. 8 is acknowledged. However, applicants have suggested that since no specific reason was given for separating claim 78 from the other claims in the original restriction requirement, that the claim needs to be examined with the rest of the claims. Since it is clear that this claim is drawn to a method for adhering a security article and is separate and distinct from the elected claims of a security article, since the method set forth is not necessary to be used with the claimed article of the elected group, claim 78 is further restricted and withdrawn from consideration.

2.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. The use of a trademarked name in a claim in order to define the limits of the claim is indefinite. See MPEP 2173.05(u).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4, 7, 14, 66-68. 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. patent of Coombs et al.

Coombs et al teach a transparent, PET substrate (31) with a multilayer interference coating including an absorber on the substrate and a dielectric on the absorber. Inherently, the substrate acts by interference (refractively) and shifts color with changing viewing angle. Coombs et al do not teach the use of a second coating on the other side of the substrate or the adhesive and release layers. However, the multiplicity of interference coatings on either side of a substrate is well

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known in the art and would have been obvious o those of ordinary skill in the art for the purpose of enhancing the efficiency of the Coombs et al filter. Additionally, the addition of adhesive and release layers to adhere the filter to an object is also well known in the area of optical devices, and such a use would have been obvious to those of ordinary skill in the art with the Coombs et al device in order to affix it onto another item for viewing purposes.

#### ***Allowable Subject Matter***

7. Claims 5, 6, 8 and 70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Additionally, in the case of claim 5, the rejection under 35 USC 112, second paragraph needs to be overcome.

8. The following is a statement of reasons for the indication of allowable subject matter: The above named claims recite specific layerings of the color shifting layer or the interference layer which are not taught or suggested by the prior art.

#### ***Conclusion***

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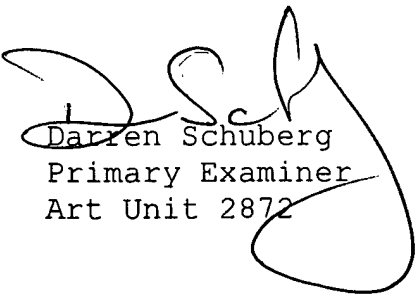
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The U.S. patent of Moraw teaches a multiple holograms on a security device on either side of a substrate (Figure 10).

10. Papers related to this application may be submitted by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number for Art Unit 2872 is (703) 308-7722.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren Schuberg whose telephone number is (703) 308-4815.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

8/13/01

  
Darren Schuberg  
Primary Examiner  
Art Unit 2872